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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,832	12/22/2005	Philippe Cornu	126441	3031

27049	7590	12/22/2009
OLIFF & BERRIDGE, PLC		
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ALEXANDRIA, VA 22320-4850		

EXAMINER	
MULVANEY, ELIZABETH EVANS	

ART UNIT	PAPER NUMBER
1794	

NOTIFICATION DATE	DELIVERY MODE
12/22/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction27049@oliff.com
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Office Action Summary	Application No. 10/561,832	Applicant(s) CORNU ET AL.	
	Examiner Elizabeth E. Mulvaney	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/8/09 has been entered.

Response to Arguments

Applicant's arguments, see Amendment, filed 10/8/09, with respect to the rejection(s) of claim(s) 18-23, 33 and 34 under 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of US 5,510,164 in view of US 6,159,573.

Applicant argues that the claims, as amended, require land recording. US 5,510,164 does not specify land and/or groove recording and does not disclose the presence of lands and grooves in the substrate. However, forming lands and grooves in a disk substrate is well-known in order to provide tracking for the laser. Further, it is well-known to record on the lands to increase the recording density of a disk. See US 6,159,573 col. 6, lines 46-54.

Applicant also argues that the reference does not specify that the recording mark is in bubble form. However, whether forming a mark by phase-change, by pit or by bubble is a matter of

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recording power/recording speed when using tellurium based materials as recording materials, i.e. this is a method limitation. The basic structure of having a tellurium based material adjacent a deformable layer is found in the '164 reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-23, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,510,164 in view of US 6,159,573.

The reference discloses a recording medium comprising a tellurium based recording layer (photosensitive layer) where the recording layer has a subbing layer between the light incident substrate and the recording layer and a deformable layer between the recording layer and a hard coat (second substrate). The subbing layer and deformable layer may be formed of the same materials (fluorinated hydrocarbon or silicone). The layers provide plastic/elastic deformation. See Embodiment 2. Further, a metal layer may be provided between the recording layer and the hard coat. The reference does not specify the thickness of the subbing and deformable layers. However, it would have been obvious to one of ordinary skill in the art to vary the thickness of each layer in the interest of optimizing their properties and optimizing production costs.

It is recognized that the reference does not disclose lands or grooves on the substrate. However, as shown in the '573 reference, forming lands and grooves in a disk substrate is well-

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known in order to provide tracking for the laser. Further, it is well-known to record on the lands to increase the recording density of a disk. See col. 6, lines 46-54. Therefore, it would have been obvious to one of ordinary skill in the art to provide lands and grooves on the '164 substrate in order to provide the tracking and dual-surface recording availability.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,510,164 in view of US 6,159,573 further in view of US 6,544,616.

The '164/'573 reference combination discloses the medium as described in the above rejection. It is recognized that the reference does not provide a teaching for a dual-layer single-sided medium, i.e. a medium having a semi-transparent and reflective layer which is read from a single side. However, the '616 reference shows that it is known to utilize multi-layered disks comprising patterned semi-transparent and patterned reflective layers for increasing the storage capacity. Further, the multiple layers are provided with multiple protective layers, i.e. multiple recording layers would require multiple deformation layers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth E. Mulvaney whose telephone number is 571-272-1527. The examiner can normally be reached on Monday-Friday 9am-5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Ruthkosky can be reached on 571-272-1291. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elizabeth E. Mulvaney/

Primary Examiner, Art Unit 1794